

REMARKS

Prior to entry of this paper, Claims 1-12 were pending. Claims 1-4, 6 and 8-10 were rejected. Claims 5, 7, 11 and 12 are provisionally withdrawn. In this paper, Claims 1 and 4 are amended. Claims 1-4, 6, and 8-10 are currently pending. The specification was also amended to remove unneeded references numbers. No new matter is added by way of this amendment. For at least the following reasons, Applicants respectfully submit that each of the presently pending claims is in condition for allowance.

Election of Species

The OA indicates that the application contains claims directed to more than one species of the generic invention. Specifically, the OA indicates that the species are:

I. Figure 4 (Claims 4, 6, 9, and 10), wherein Figure 4 shows a tolerance ring with protrusions extending radially outward from a band and shows a guide portion that also extends radially outward from the band; and

II. Figure 6 (Claims 5, 7, 11, and 12), wherein Figure 6 shows a tolerance ring with protrusions extending radially inward from a band and shows a guide portion that also extends radially inward from the band.

The OA further indicates that Claims 1-3 and 8 are generic claims. Applicants affirm the oral provisional election of species I with traverse made by Mr. John Branch on April 24, 2007.

The OA indicates that the species above do not relate to a single general inventive concept under PCT Rule 13.1 because they lack the same or corresponding special technical features. However, the reasons given are that the special technical features are common in each of the species and known from the same cited reference, Blaurock et al. (3,838,928). The OA also indicates that the special technical features do not define a contribution over the prior art. Further the OA indicates that the lack of unity is based on a posteriori (e.g., knowledge derived from experience).

Applicants respectfully contend that there is no undue burden if restriction is not required. The OA does not indicate that the species represent separate classifications. The OA is also contradictory in that it first indicates that the species lack the same or corresponding special

Drawing Objections

Claim Objections

Claim Rejections – 35 USC § 112

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Claim 1, such that a perceived contradiction is not possible. The OA notes that Claims 2-4, 6, and 8-10 depend from Claim 1. Accordingly, Applicants respectfully request that the rejections of Claims 1-4, 6, and 8-10 under 35 U.S.C. 112, second paragraph, be withdrawn.

Claim Rejections -35 USC § 102

Claims 1-4, 6, and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Blaurock et al., 3,838,928. Blaurock is directed to a spacer element formed with transversely juxtaposed rows of alternating, trough-shaped recesses and integral projections in each major face. See Blaurock, abstract. Applicants respectfully disagree that Blaurock discloses all of the claim limitations.

For instance, Blaurock teaches away from corrugated protrusions extending *either* radially outwards from the band or radially inwards toward the axis of the band. See e.g., Blaurock, col. 1, lines 11-41. Instead, Blaurock discloses “projections on both major faces.” Blaurock, col. 1, lines 62-63. Correspondingly, Blaurock does not disclose at least one guide surface inclined relative to the axis of the band such that the free end of the guide portion is wider than the opening of the band when the corrugated protrusions extend radially outwards, and is narrower than the opening of the band when the corrugated protrusions extend radially inwards. Blaurock’s invention can not include this limitation, because Blaurock’s protrusions extend in both directions.

Nevertheless, Applicants have amended independent Claim 1 to explicitly state that the protrusions extend in a common radial direction away from the band, and that the guide surface is also inclined in the radial direction of the protrusions such that a free end of the guide portion defines an opening of a size other than that defined by the band. Support is found throughout the specification, including Figures 4 and 6, and published Spec., paras. 15-24. As indicated above, Blaurock teaches away from tolerance rings with protrusions in a common direction. See e.g., Blaurock, col. 1, lines 11-41. Accordingly, Blaurock also teaches away from the guide portion as claimed. Blaurock also specifically teaches away from a spacer with an inclined edge portion, because it would not survive repeated jamming in a gap. See, Blaurock, col. 4, lines 51-64.


Since Blaurock does not disclose all of the limitations of amended independent Claim 1, Applicants respectfully request that the rejection of independent Claim 1 under 35 U.S.C. 102(b) be withdrawn. It is well established that dependent claims are patentable for at least the same reasons as their corresponding independent claims. Accordingly, Applicants respectfully request that the rejection of dependent Claims 2-4, 6, and 8-10 under 35 U.S.C. 102(b) also be withdrawn.

CONCLUSION

It is respectfully submitted that each of the presently pending claims is in condition for allowance and notification to that effect is requested. Examiner is invited to contact the Applicants' representative at the below-listed telephone number if it is believed that the prosecution of this application may be assisted thereby. Although only certain arguments regarding patentability are set forth herein, there may be other arguments and reasons why the claimed invention is patentable. Applicant reserves the right to raise these arguments in the future.

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Respectfully submitted,

By 
Thomas R. Marquis

Registration No.: 46,900
DARBY & DARBY P.C.
P.O. Box 770
Church Street Station
New York, New York 10008-0770
(206) 262-8900
(212) 527-7701 (Fax)
Attorneys/Agents For Applicant